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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,624	07/15/2004	Rauno Rantanen	FORSAL-92	2220
36528	7590	01/03/2007	EXAMINER	
STIENNON & STIENNON 612 W. MAIN ST., SUITE 201 P.O. BOX 1667 MADISON, WI 53701-1667			TADESSE, YEWEBDAR T	
		ART UNIT	PAPER NUMBER	
				1734
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE		DELIVERY MODE	
3 MONTHS	01/03/2007		PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/501,624	RANTANEN, RAUNO	
	Examiner Yewebdar T. Tadesse	Art Unit 1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 21-23 and 25-33 is/are pending in the application.  
 4a) Of the above claim(s) 25-32 is/are withdrawn from consideration.  
 5) Claim(s) 22-23 is/are allowed.  
 6) Claim(s) 21 and 33 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 21 and 33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 21 and 33 (see line 1 each) the limitation that the apparatus being "in a paper or board machine" is new matter. It is noted by applicant that paragraph 57, the phrase "treatment is carried out in a forming section" supports the language used in a paper or board machine (see claim 21 and 33). Examiner respectfully disagrees because the phrase "forming section" is not equivalent to "machine". According to Merriam-Webster's dictionary (see enclosed), a machine is "an assemblage of parts that transmits forces, motion and energy one to another in a predetermined manner or an instrument designed to transmit or modify the application of power, force or motion.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tooker (US 5,417,797) in view of Reckziegel (US 4,984,949) and DE 37 14226A1.

Tooker discloses (see Fig 1, column 2, line 61-column 3, line 13) an apparatus for feeding a treating agent onto a book block capable of being a continuous moving paper or board web comprising: a feed apparatus (source 16) having at least one feed chamber, the feed chamber having at least one inlet opening for the treating agent and at least one outlet opening for the treating agent (PUR); at least one nozzle plate (18) which communicate with the at least one outlet opening of the at least one feed chamber; at least one downwards sloping inclined surface (trough 22) positioned to receive the downwards moving jet of treating agent from the hole in the at least one nozzle plate, the at least one inclined surface forming a downwards sloping flow path on which an even laminar treating agent flow may be formed, the at least one inclined surface having portions forming a lowermost edge (see Fig 1); and an applicator rod (roller 12) forming a cylindrical surface, the applicator rod mounted for rotation so that

the cylindrical surface also rotates and positioned such that the lowermost edge of the at least one inclined surface rests against the cylindrical surface, wherein the cylindrical surface is in contact with the continuous moving surface. Tooker lacks teaching a plurality of holes forming downwardly moving jets of treating agent. However, it is well known in the art to use a plurality of holes forming jets of coating agent depending the size of the substrate. For instance Reckziegel discloses a multi-hole nozzles for application of PUR melt adhesive over thicker, high-volume papers. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a plurality of holes in Tooker depending the increased thickness of the substrate. In Tooker the continuous moving surface is not positioned below the applicator rod. However, one in the art would arrange the moving substrate below or above the applicator rod depending the space available in installing the treating apparatus within the production area. It is well known in the art to position a book block (moving surface) beneath the applicator rod; for instance - DE'226 discloses (see Figure) a moving surface, capable of being a continuous moving paper or board web, situated below the applicator rod (20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to position the moving surface beneath the applicator rod in Tooker as desired.

6. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tooker (US 5,417,797) in view of Reckziegel (US 4,984,949).

Tooker discloses (see Fig 1, column 2, line 61-column 3, line 13) an apparatus for feeding a treating agent onto a book block capable of being a continuous moving paper or board web comprising: a feed apparatus (source 16) having at least one feed chamber, the feed chamber having at least one inlet opening for the treating agent and at least one outlet opening for the treating agent (PUR); at least one nozzle plate (18) which communicate with the at least one outlet opening of the at least one feed chamber; at least one downwards sloping inclined surface (trough 22) positioned to receive the downwards moving jet of treating agent from the hole in the at least one nozzle plate, the at least one inclined surface forming a downwards sloping flow path on which an even laminar treating agent flow may be formed, the at least one inclined surface having portions forming a lowermost edge (see Fig 1); and an applicator rod (roller 12) forming a cylindrical surface, the applicator rod mounted for rotation so that the cylindrical surface also rotates and positioned such that the lowermost edge of the at least one inclined surface rests against the cylindrical surface, wherein the cylindrical surface is in contact with the moving surface. Tooker lacks teaching a plurality of holes forming downwardly moving jets of treating agent. However, it is well known in the art to use a plurality of holes forming jets of coating agent depending the size of the substrate. For instance Reckziegel discloses a multi-hole nozzles for application of PUR melt adhesive over thicker, high-volume papers. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a plurality of holes in Tooker depending the increased thickness of the substrate.

***Allowable Subject Matter***

7. Claims 22-23 are allowed.
  
8. The following is an examiner's statement of reasons for allowance: see reasons for allowance of claims 22-23 on the action mailed on 08/29/2006.

***Response to Arguments***

9. Applicant's arguments filed 11/24/2006 have been fully considered but they are not persuasive. Applicant's claimed invention (re amended claims 21 and 33) is not distinguished from Tooker in view of others (see above) because the apparatus disclosed by Tooker as modified by others is capable treating a moving paper or board web. Applicant's main argument is that Tooker and other cited references disclose periodic or discontinuous process of coating. It is noted these claims are not directed to the process of coating, at the issues here are structural limitations of the apparatus. As described above Tooker as modified meets applicant's claimed apparatus. The added limitation that "a continuous moving paper or board web is intended use of the apparatus.

Furthermore, a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus shows all of the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) Furthermore, "**expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim.**" *Ex parte Thibault*, 164 USPQ 666,667 (Bd. App. 1969). Thus, the

**"inclusion of material or article worked upon does not impart patentability to the claims."** *In re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 (USPQ 458, 459 (CCPA 1963))). In this case, the article worked upon (the continuous paper or board web) does not impart patentability to the claimed apparatus.

As to the argument that in Tooker the leading edge is not in contact with the roller (12). Examiner respectfully disagrees because Tooker teaches (see column 4, lines 15-17) that cylinder (24) push the leading edge (22a) against roller, in which the edge is considered to be in contact with the roller.

As to argument that Reckziegel does not disclose a nozzle plate, Tooker discloses a nozzle plate (18).

In response to applicant's argument that Tooker is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention.

See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Tooker discloses a feeding apparatus with inclined surface and a roller to apply a metered amount of coating material, which is pertinent to applicant's feed apparatus evening out the coating material.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yewebdar T. Tadesse whose telephone number is (571) 272-1238. The examiner can normally be reached on Monday-Friday 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Yewebdar T. Tadesse*

YTT